

REMARKS

With this Response, no claims are amended or canceled. Claims 23-69 are currently added. Therefore, claims 1-69 are pending.

ALLOWABLE SUBJECT MATTER

Claims 20-21 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all limitations of the base claims from which they depend. Applicant submits that the rejection of the independent base claim from which claims 20-21 depend has been overcome herein. Therefore, Applicant respectfully submits that claims 20-21 are allowable as written.

CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 1-13, 17-19, and 22

Claims 1-13, 17-19, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,434,371 issued to Claxton (*Claxton*) in view of U.S. Patent No. 5,337,346 issued to Uchikura (*Uchikura*). Applicant respectfully submits that these claims are not rendered obvious by the cited references for at least the following reasons.

Claim 1 recites in part the following:

a switch, coupled to power supply and to the computing unit, to selectively couple the radio communication unit to the power supply, to provide first and second modes of operation, wherein the **first mode of operation enables the computing unit and the radio communication unit, and the second mode of operation disables the radio communication unit and enables the computing unit.**

Claims 9 and 17 recite similar limitations directed to a mode of operation where local functionality and communication functionality are both enabled, and a mode of operation where local functionality is enabled and communication functionality is disabled.

At page 2, the Office Action asserts that *Claxton* discloses a switch "to selectively couple the radio communication unit to the power supply (Col. 4, Lines 35-49)." Applicant must respectfully disagree. The cited section of *Claxton* makes clear that "one end of switch 302 is connected to a ground 306. The other end of switch 302 is connected to a microprocessor 304 [and a voltage source]." Thus, it is the microprocessor, part of *Claxton*'s PDA, that is selectively connected to a power supply. Applicant notes that *Claxton* does not disclose or suggest a switch to selectively couple the radio communication unit to the power supply as asserted. Therefore, the cited reference provides no support for this assertion.

The Office Action at page 9 further asserts:

Claxton discloses a switch that can be activated using the flip cover to determine the operating mode of the system.... Therefore, one skilled in the art would recognize that the switch (controlled by the flip cover) of the communication device of Claxton **would have to inherently couple the communication device to the power supply** in order to bring power to the device so that one or both of the wireless telephone and the PDA can be activated in the corresponding SMARTPHONE and KEYPAD mode, respectively.

Applicant does not disagree that the communication device must inherently couple to the power supply. However, the issue is not whether the communication device is coupled to the power supply, but **whether the switch couples the power supply to the communication device.**

Applicant notes that Claxton makes clear that in **both** the SMARTPHONE and the KEYPAD modes, **the communication device is powered, and active.** Thus, the switch in Claxton necessarily cannot connect the communication device to the power supply, because the communication device is **always active.** Thus, the PDA functionality is available in **only one** mode, and the cellphone function is active in **both** modes. In contrast, Applicant claim a mode of operation where local functionality is enabled and communication functionality is disabled.

The Office Action at page 3 further cites *Uchikura*. The Office Action at page 9 further asserts: "the applicant argues that *Uchikura* only teaches one mode of operation." Applicant must disagree; this is a misinterpretation of Applicant's Response. Applicant's Response clearly states that "**the electronic functionality** can only be operable in a single mode." Thus, Applicant asserts that the electronic functionality is only operable in a single mode. Applicant notes that the electronic functionality can only be operable in a single mode, in contrast to the claimed invention, because the keys required to operate the mode are inaccessible during the **other mode**. When *Uchikura's* switch is on, the device acts as a cellphone (with the radio communication circuit enabled), and the electronic notebook function **disabled**. When *Uchikura's* switch is off, the converse is true, where the radio communication circuit is disabled, and the electronic notebook function is enabled. See col. 3, lines 39 to 56. If *Uchikura's* electronic notebook could be interpreted as a computing device or as local functionality, *Uchikura* at most suggests the use of the computing device or local functionality during only a single mode.

Applicant notes that the Office Action at page 9 further asserts:

Uchikura, once combined with Claxton provides two modes of operation wherein the first mode of operation enables the computing unit and the radio communication unit. In the second mode, the computing unit is enabled and the radio communication unit is disabled.

Applicant further notes that the Office Action provides **no support** for this contention. The mere making of an assertion does not make the assertion true. As shown, the references fail, alone or in combination, to support the interpretation given in the Office Action.

Thus, even assuming it is proper to combine the references, which Applicant does not concede, both *Claxton* and *Uchikura* fail to disclose or suggest, alone or in combination, a **first mode** of operation **enables the computing unit and** the radio communication unit, and the

second mode of operation disables the radio communication unit and **enables the computing unit**, as recited in claim 1, or the similar limitations of claims 9 and 17. Thus, the cited references fail to set forth at least one limitation of the claims in contrast to MPEP §2143, which requires every limitation to be shown in the cited references to establish a prima facie case of obviousness.

Claims 2-8 depend from claim 1. Claims 10-13 depend from claim 9. Claims 18-19 and 22 depend from claim 17. Because dependent claims necessarily include the limitations of the claims from which they depend, Applicant submits that these claims are not rendered obvious by the cited references for at least the reasons set forth above.

Furthermore, claims 20-21, objected to in the Office Action, depend from claim 17, and likewise include the limitations of claim 17, from which they depend. Thus, Applicant submits that these claims are not rendered obvious by the cited references for at least the reasons set forth above, and respectfully requests that the objection to these claims be withdrawn.

Claims 14-16

Claims 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Claxton* and *Uchikura* in view of U.S. Patent No. 5,983,073 issued to Ditzik (*Ditzik*). Applicant respectfully submits that these claims are not rendered obvious by the cited references for at least the following reasons.

The Office Action cites *Ditzik* as disclosing providing communication between a mobile device and an external entity. Whether or not *Ditzik* discloses what is asserted in the Office Action, which Applicant does not concede, the rejection of these claims is based upon a defective combination of *Claxton* and *Uchikura*, as discussed above. Furthermore, Applicant notes that the Office Action makes reference to the communication means, or external

communication control 54 of Fig. 7 of *Ditzik*. Even assuming the communication control of *Ditzik* enables a computing device with radio communication capability, Applicant respectfully submits that *Ditzik* fails to disclose or suggest selectively switching between a **first mode** of operation in which **both wireless communication and local functionality** are enabled, and a **second mode** of operation in which the communication functionality is disabled and the local functionality is enabled, as recited in claim 9. Therefore, Applicant respectfully submits that the cited references fail, whether alone or in combination to disclose or suggest the invention as recited in the independent claims. Because the cited references fail to disclose every aspect of the independent claims, Applicant submits that claims 14-16, which depend from claim 9, are not rendered obvious by the cited references for at least the reasons set forth with respect to claim 9.

NEW CLAIMS

Applicants present herein new claims 23-69 for examination. Applicants respectfully submit that these claims include at least one limitation not found in the cited references. Therefore, these claims are not rendered obvious by the cited references.

CONCLUSION

For at least the foregoing reasons, Applicant submits that the rejections have been overcome, placing all pending claims in condition for allowance. Such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number
02-2666.

Respectfully submitted,
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Date: 10/14/04

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